REMARKS

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-3, 7-9, and 13-15 are presently pending. Claims amended herein are 1, 7, and 13. Claim withdrawn or cancelled herein

5   is 4-6, 10-12 and 16. New claims added herein are none.

Herein, the "Action" or "Office Action" refers to the Office Action dated 12/23/2004.

Claim Objections

10   The Office indicated the "such images" term used in claims 1, 7, and 13 should be identified as "selected," "inserted," or "collected" images. Applicant amends claims accordingly.

Substantive Claim Rejections

15   **Claim Rejections under §§ 102 and 103**

The Office rejects all of the pending claims (1-3, 7-9, and 13-15) under §102 and/or §103. For the reasons set forth below, the Office has not shown that one or more of the cited references anticipate the rejected claims. For the reasons set forth below, the Office has not made a *prima facia* case showing

20   that the rejected claims are obvious (under §103). Accordingly, Applicant respectfully requests that the rejections be withdrawn and the case be passed along to issuance.

The Office's rejections are based upon the following references:

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- **Morag:** *Morag et al.*, US Patent No. 6,324,545 (issued 11/27/2001 and filed 10/15/1997); and/or

- **Narayen:** *Narayen et al.*, US Patent No. 6,035,323 (issued 3/7/2000 and filed 10/24/1997).

5

Overview of the Application

The Application describes a technology for facilitating the ease of handling and exchange of digital images. A set of selected digital images are collected together into a self-contained package called a photo album. These

10 images may be of differing digital formats. Alternatively, they may be all converted onto a common format.

The album includes the selected images and executable software to view such images. This album may be transmitted (typically, via email) to another via a network, such as the Internet.

15

Cited References

The Office cites **Morag** as its reference for is anticipation-based rejections and the primary references in its obviousness-based rejections. The Office cites **Narayen** as its secondary reference in its obviousness-based

20 rejections.

Morag

Morag describes a method of generating an album, comprising: providing a plurality of digitally encoded images, automatically arranging at

25 least some of the images to fit a format of an album and printing a photograph

album using the determined arrangement. Preferably, each page of the album is a single sheet of photographic paper.

Narayen

5   Narayen describes technology for publishing a collection of digital media on a network. In one example of a method, a client digital processing system generates a collection of digital media and transmits collection information, which describes the collection of digital media, to a server digital processing system. From the collection information, a plurality of presentable

10   media is automatically generated; each of these presentable media is capable of being presented to other client digital processing systems which are coupled to the network. In this one example, the network is operating according to a hypertext transfer protocol. In this one example, the client and server systems are programmed to interact together such that the presentable media is

15   automatically generated.

Anticipation Rejections

Anticipation Rejections Based upon Morag

20   The Office rejects claims 1-3, 5-9, and 11-15 under USC § 102(e) as being anticipated by Morag. Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Office to withdraw its rejections of these claims.

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Claim 1

In the Action, the Office provides the following reasoning for rejecting this claim:

> 6.   With respect to Claim 1, Morag teaches a method for facilitating the ease of handling and exchange of digital images, the method comprising: obtaining a set of multiple digital images (Col. 5 lines 46-59); facilitating selection of images from the set (Col. 6 lines 5-15); collecting the selected images into a self-contained album (Col. Lines 24-44), wherein the album comprises the selected images (Col. 6 lines 24-35) and computer executable instructions for viewing such images (Col. 6 lines 35-41).

5   Herein, Applicant amends claim 1. The amended text is indicated by double underscores. In part, amended claim 1 reads:

- obtaining a set of multiple digital images, <u>wherein one or more of the images of the set of multiple digital images are a digital-image</u>
10   <u>format that differs from the digital-image format of one or more of the other images of the set of multiple images</u>;
- facilitating selection of images from the set, <u>wherein one or more of the selected images are a digital-image format that differs from the digital-image format of one or more of the other selected</u>
15   <u>images</u>;
- <u>choosing computer-executable instructions for viewing selected images, wherein the chosen computer-executable instruction facilitates viewing of selected images in each of the differing digital-image formats of the selected images</u>;
20   - collecting the selected images into a self-contained album, wherein the album comprises the selected images and <u>the chosen</u> computer-executable instructions for viewing the selected images.

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The amended text is not disclosed in the cited reference. **Morag** does not discuss or disclose images being in different digital-image formats (e.g., JPEG). It also does not discuss choosing executable instructions that are configured to handle the differing formats.

5   Applicant submits that **Morag** does not disclose all of the claimed elements and features of this amended claim. Furthermore, the combination of **Morag** and **Narayen** does not disclose of the claimed elements and features of this amended claim. Accordingly, Applicant asks the Office to withdraw its rejection of these claims.

10

Claims 2-3

These claims ultimately depend upon independent claim 1.   As discussed above, claim 1 is allowable.

In addition to its own merits, each of these dependent claims is
15   allowable for the same reasons that its base claim is allowable.   Applicant submits that the Office withdraw the rejection of each of these dependent claims because its base claim is allowable.

Claim 7

20   In the Action, the Office provides the following reasoning for rejecting this claim:

11.   With respect to Claim 7, Morag teaches a method for generating a self-contained album of digital images, the method comprising: inserting images into an album (Col. 6 lines 5-15 and 24-31); inserting computer executable instructions for viewing such images into the album (Col. 6 lines 33-41).

Herein, Applicant amends this claim. The amended text is indicated by double underscores. In part, this amended claim reads:

5
* inserting images into an album, <u>wherein one or more of the inserted images have a digital-image format that differs from the digital-image format of one or more of the other inserted images</u>;
* <u>choosing computer-executable instructions for viewing inserted images, wherein the chosen computer-executable instruction facilitates viewing of inserted images in each of the differing digital-image formats of the inserted images</u>;
10
* inserting <u>the chosen</u> computer-executable instructions into the album.

15
The amended text is not disclosed in the cited reference. **Morag** does not discuss or disclose images being in different digital-image formats (e.g., JPEG). It also does not discuss choosing executable instructions that are configured to handle the differing formats.

Applicant submits that **Morag** does not disclose all of the claimed elements and features of this amended claim. Furthermore, the combination of

20
Morag and **Narayen** does not disclose of the claimed elements and features of this amended claim. Accordingly, Applicant asks the Office to withdraw its rejection of these claims.

Claims 8-9

25
These claims ultimately depend upon independent claim 7. As discussed above, claim 7 is allowable.

In addition to its own merits, each of these dependent claims is allowable for the same reasons that its base claim is allowable. Applicant

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submits that the Office withdraw the rejection of each of these dependent claims because its base claim is allowable.

Claim 13

5   In the Action, the Office provides the following reasoning for rejecting this claim:

16.   With respect to Claim 13, Morag teaches acomputer-readable medium having computer-executable instructions that, when executed by a computer, performs a method for facilitating the ease of handling and exchange of digital images, the method comprising: collecting images into a self-contained album (Col. 6 lines 5-15 and 24-31); inserting computer executable instructions for viewing such images (Col. 6 lines 33-41).

Herein, Applicant amends this claim. The amended text is indicated by double underscores. In part, this amended claim reads:

10

* collecting images into a self-contained album, wherein one or more of the collected images have a digital-image format that differs from the digital-image format of one or more of the other collected images;

15

* converting one or more of the collected images into a common digital-image format so that all of the collected images have the same common digital-image format;

* inserting computer executable instructions for viewing the collected images.

20

The amended text is not disclosed in the cited reference. Morag does not discuss or disclose images being in different digital-image formats (e.g., JPEG). It also does not discuss converting the different formats into one common format.

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Applicant submits that **Morag** does not disclose all of the claimed elements and features of this amended claim. Furthermore, the combination of **Morag** and **Narayen** does not disclose of the claimed elements and features of this amended claim. Accordingly, Applicant asks the Office to withdraw its

5 rejection of these claims.

Claims 14-15

These claims ultimately depend upon independent claim 13. As discussed above, claim 13 is allowable.

10 In addition to its own merits, each of these dependent claims is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each of these dependent claims because its base claim is allowable.

15

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

Applicant disagrees with the Office's obviousness rejections. Arguments presented herein point to various aspects of the record to

20 demonstrate that all of the criteria set forth for making a *prima facie* case have not been met.

Based upon Morag and Narayen

The Office rejects claims 4, 10, 16 under USC § 103(a) as being

25 unpatentable over **Morag** in view of **Narayen**. Applicant respectfully traverses

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the rejection of this claim. Applicant asks the Office to withdraw its rejection of this claim.

This rejection is moot. Application has canceled these claims.

5   **Dependent Claims**

In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is allowable.

10   **Conclusion**

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Office is urged to contact the undersigned attorney before issuing a subsequent Action.

15

Respectfully Submitted,

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